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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PELHAM, JOSEPH MOORE

ART UNIT PAPER NUMBER

3742

DATE MAILED: 11/24/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/865,920

Applicant(s)

SANONER ET AL.

Examiner

Joseph M Pelham

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-11, 13, 16-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, 13, 16-25 and 27-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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1. The examiner acknowledges Applicant's submission of the amendment filed 9/15/03. Claims 1-6, 8-11, 13, 16-25, and 27-31 are now pending.

***Claim Rejections - 35 USC § 103***

2. Claims 1-6, 8-11, 16-25, and 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6140614 to Padamsee in view of U.S. Patent 5678925 to Garmaise et al, French patent document 2737380 to David, and U.S. Patent 5842353 to Lin (Kuo-Liang in the patent).

Referring to Figure 1 and column 3, lines 49-51, especially, Padamsee discloses or suggests an electrically heated mug substantially as claimed, including, including thermostat 48 and lid. Padamsee does not disclose control means attached to the mug for user selection of temperature, depressible key means for temperature selection, LED or LCD visual temperature display, a buzzer indicating a desired temperature, heater control which activates heating at 2°F below and deactivates heating above the set point temperature, a temperature set key allowing single degree or rapid temperature increments, and an LED array to indicate temperature.

Garmaise et al discloses, at Figure 1 and column 5, lines 25-32, at least, temperature display 13, for which LED or LCD are conventional, and control means 18a integrally attached to an outer surface of a drinking mug. David discloses a heater power control 10 attached to the outer surface of a mug (see Figure 5 and the abstract). Lin discloses, at Figure 1, the desirability of solid state control means 18 for user selection of temperature for a portable beverage warmer having visual temperature display 22. It would have been obvious to integrally attach the control unit to the side of the mug, after the manner of Garmaise et al, and to include heater power control means, as shown by David, for the sake of more convenient monitoring and control by the user, to combine the control enhancements in solid state as suggested by Lin to allow more compact and convenient temperature selection by the user.

The examiner notes that depressible key means for temperature selection, including selectively single degree or rapid temperature increments, a buzzer for indicating a desired temperature, control means which activate heating at 2°F below and deactivates heating above the set point temperature, and an LED array to indicate temperature are all well known and conventional adjuncts to household heating devices and hence cannot be regarded to patentably distinguish the claimed invention from the prior art of record. It would have been obvious to utilize depressible key means with single degree or rapid temperature increments for temperature selection to allow efficient single finger control, to utilize an LED array to indicate temperature simply, to include a buzzer to avoid the hazard of visual monitoring during operation of a motor vehicle, and to employ a 2°F temperature control tolerance to accommodate the coffee drinker of exacting tastes.

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3. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Padamsee in view of Garmaise et al, David, and Lin, as applied to claims 1-6, 8-11, 16-25, and 27-31 above, and further in view of U.S. Patent 5042258 to Sundhar.

The claims differ from Padamsee in view of Garmaise et al, David, and Lin in calling for a removable mug liner. However, Sundhar discloses a removable mug liner 25 (see Figure 2 and column 3, lines 19-22). It would have been obvious to adapt the liner of Sundhar to the mug suggested by Padamsee in view of Garmaise et al, David, and Lin to allow convenient cleaning of the vessel.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-6, 8-11, 16-25, and 27-31 have been considered but are not persuasive.

Applicants argue, at page 9, 1st full paragraph of the Amendment, that “[c]learly, the references ...provide no suggestion that the references be combined.” The Examiner urges that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some ***teaching, suggestion, or motivation*** to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the temperature indicating and switch means of Garmaise et al is explicitly intended, inter alia, to avoid scalding the user, which is a compelling motivation to so modify the mug of Padamsee; the integral temperature control of David enhances user control of the heating process, the desirability of which has long been imperative in food preparation appliances, with the further enhanced control means of Lin being motivated by the same imperative.

Applicants' assertion that incorporating the control module of Lin would “change the principle of operation” of the device of Lin, which Applicants' assert teaches away from the claimed invention, is not persuasive. As discussed in the previous Office Action, this line of reasoning is mistaken firstly because it considers the bodily incorporation of the entire structure of Lin. Again, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The device of Lin comprises thermoelectric heating components, the space requirements of which mandate a separate control module for the sake of providing a usable mug 62 (Figure 4), which embodiment further relocates the heat sink from the vessel to the base. Lin is relied upon for its teaching of enhanced temperature control and display.

Secondly, in fact the requirement that a “proposed modification cannot change the principle of operation of a reference” ***pertains to the primary reference*** (M.P.E.P. 2143.02). The

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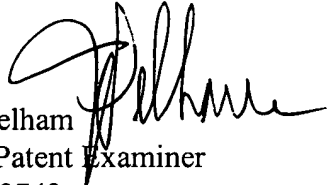
principle of operation of Padamsee, being the resistive heating of a portable drinking mug, is not changed; it is precisely supplemented by enhanced control means.

The mug of Padamsee is intended to be a self-contained unit for use in an automobile; Garmaise et al and David disclose integral control and display means for portable drinking vessels, and Lin substantially discloses the combination of control enhancements in compact form.

The need for compactness in a portable mug militates against the bodily incorporation of the structure of Lin, which would moreover require the entire thermoelectric structure; Garmaise et al and David teach control means integral with the side wall of the mug, immediately suggesting that the enhanced control means of Lin may be incorporated into the mug of Padamsee without compromising convenience.

***Conclusion***

5. Any inquiry concerning communications from the Examiner should be directed to Joseph Pelham at (703) 308-1709; fax: 703-872-9302 (before final), 703-872-9303 (after final), 703-872-9301 (customer service).

  
Joseph Pelham  
Primary Patent Examiner  
Art Unit 3742

JMP  
November 11, 2003